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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/840,121 | 04/24/2001 | Rina Hayasaka | 040405/0336 | 2660 |
| 22428 | 7590 | 12/28/2005 | EXAMINER | |
| FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007 | | | CHANG, SHIRLEY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2614 | |

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/840,121 | HAYASAKA ET AL. | |
| | Examiner | Art Unit | |
| | Shirley Chang | 2614 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10/12/05
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 9-11, 13-15 and 27 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 12, 16-26, and 28 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 9-11, 13-15 and 27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 4/24/01 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/20/05, 4/24/01, 8/3/04, 11/18/04
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Election/Restrictions

Claims 1-8, 12, 16-26, and 28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/12/05.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 9-11, 13-15, and 27 are rejected under 35 U.S.C. 101 because the claims are directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. Id. At 1551.

The claimed invention is directed to non-statutory subject matter. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. Claims 9-11, 13-15, and 27 claim both a method and a system. See MPEP 2173.05(p) II.

The examiner suggests rewriting the preamble of the claim to read as follows: “a composite media file broadcasting program broadcasting control method, said method comprising the steps of.”

Claim Rejections - 35 USC § 112

2. Claims 9-11, 13-15, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 9-11, 13-15, and 27, see MPEP 2173.05(p) II. In particular, claim 9 claims both an apparatus and the method steps of using the apparatus and is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

Regarding claim 13, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Specification

The disclosure is objected to because of the following informalities: the Brief Summary of the Invention is not a general statement of the invention as set forth in 37 CFR 1.73. in particular, the summary appears to primarily comprise a verbatim recitation of the presented claims and as such does not specifically disclose quickly and readily apprise the public as to what the invention entails give as prescribed in MPEP 608.01(d). Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claim(s) 9 is/are rejected under 35 U.S.C. § 103(a) as being unpatentable over Boetje et al. (6198906).

As to claim 9,

Boetje discloses:

A composite media file broadcasting program broadcasting control method in a composite media file broadcasting program broadcasting control system including an organizing unit managing program frame and time frame of CM in the program frame (fig. 1, element 110),

producing unit generating a composite media file to be broadcasted and broadcasting schedule information (fig. 1, element 130),

broadcasting unit performing broadcasting of broadcasting data to a transmission line according to information provided from said organizing unit and said producing unit (fig. 1, element 145),

and a trigger input device designating modification of broadcasting data of the program on broadcasting to said broadcasting unit, said method comprising the steps of: setting information to broadcasting schedule information map storing broadcasting start timing without setting real time value as broadcasting start timing of a plurality of said broadcasting schedule information map in hierarchy ('constraints are created as a result of the specified interval relations and are recalculated when the relations change during any phase of the broadcast process; ordinal constraints such as relative or qualitative are set for the play structure, or 'information map' [14, 66] to [15, 26]);

storing time object and attribute information thereof expressing one point on a time axis in the broadcasting schedule information map storing the broadcasting start timing (interval relations [14, 66] to [15, 26]);

enabling broadcasting preparatory process in said broadcasting unit even in a condition where broadcasting start timing is not fixed by expressing order of time by time expressing function provided for said time object (ordinal constraints such as relative or qualitative are set for the play structure, or 'information map' [14, 66] to [15, 26]);

performing broadcasting instantly responding to determination of broadcasting start timing during broadcasting ('system evaluates constraints, relative to current duration of live program, and eliminates programs that are too long to play to completion following the live broadcast and completing before the specified hard time [14, 66] to [15, 26]).

Although Boetje does not specifically disclose setting pointer information, the examiner gives Official Notice that it is notoriously well known in the art to utilize pointers.

Accordingly, it would have been obvious to one of ordinary skill in the art to modify Boetje so as to set/use pointers in order to utilize memory efficiently. These concepts are well known in the art and do not constitute a patentably distinct limitation, per se [M.P.E.P. 2144.03].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- Kim (6209131) is directed toward processing additional information.
- Schmelzer (5424770) is directed toward automatic insertion of a TV signal.
- Perine (4814883) is directed toward multiple input/output.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley Chang whose telephone number is (571) 272-8546. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SC

Mark Behman
PATENT EXAMINER
ART UNIT 2614